

REMARKS

This is intended as a full and complete response to the Office Action dated April 15, 2004, having a shortened statutory period for response set to expire on July 15, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 11-31 remain pending in the application and are shown above. The Examiner asserts that claims 11-31 are subject to a restriction and/or election requirement and Applicants are required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner states that currently, claims 11-17 and 20-25 are generic.

Restriction to one of the following inventions is required under 35 U.S.C. §121.

- I. Species A (claim 18): triblock copolymer
- II. Species B (claims 18-19 and 26-31): a mixture of tri or multi block, and a diblock copolymer

On April 13, 2004, a telephonic interview was conducted between the Examiner and Applicants' representative, Keith M. Tackett, wherein Applicants provisionally elected Species B, with traverse. Applicants herein acknowledge election of claims 18-19 and 26-31, drawn to Species B, with traverse, and request prosecution of the elected claims along with the generic claims 11-17 and 20-25.

In order for an election requirement under 35 U.S.C. § 121 to be properly asserted, examination of the claims without restriction must impose a serious burden on the examiner. (MPEP § 803) Although claim 18 is not generic, claim 18 is a Markush-type claim, wherein the styrenic block copolymer comprises a polymer selected from groups consisting of a triblock copolymer and a mixture of a diblock copolymer and a triblock copolymer. MPEP § 803.02 specifically states as to Markush-type claims that, if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. Therefore,

an examination of all of restricted claim 18 would not constitute an undue burden on the Examiner.

In addition, claims to be restricted to different species must be mutually exclusive. (MPEP § 806.04(f)) The two species asserted by the Examiner to be recited in claim 18, specifically, a triblock copolymer and a mixture of a tri or multi block and a diblock copolymer, are not mutually exclusive. As per MPEP § 806.04(f), the general test as to whether claims are restrictable to different species is whether one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. Here the asserted species are recited within one claim, but the limitations of the first asserted species (triblock copolymer) are present in the second asserted species (mixture of a diblock copolymer and a triblock copolymer). Therefore, Applicants respectfully request withdrawal of the restriction requirement.

Claims 21 and 26-27 stand objected to based on an informality in the units of measure recited therein. Applicants have amended claims 21 and 26-27 as requested by the Examiner. As the bases for these objections have been obviated, Applicants respectfully request they be withdrawn.

Applicants have amended claims 12-14 and 16-30 to more clearly recite embodiments of the invention. These amendments are not presented to distinguish a reference, thus, the claims as amended are entitled to a full range of equivalents if not previously amended to distinguish a reference. Reconsideration of the rejected claims is requested for reasons presented below.

Claims 11-18 and 20-25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Specifically, the Examiner asserts that the rejected claims are clearly vague, indefinite and fail to particularly point out and distinctly claim elected Species B.

Applicants respectfully traverse this rejection. The Examiner has stated that claims 11-17 and 20-25 are generic. Additionally, the Examiner has noted that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. As such, unless the Examiner finds the claims directed to the elected species unpatentable, the Examiner must examine the generic claims. Claims 11-18 and 20-25 are not vague as they clearly define embodiments of Applicants' disclosed invention. Furthermore, as stated in MPEP § 2173.04, breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689 (CCPA 1971). With respect to claims 11-18 and 20-25, Applicants respectfully request this rejection be withdrawn.

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/26103 (*Zech, et al.*) either individually, or in view of WO 00/12592 (*Kadri*).

Applicants respectfully traverse this rejection. When the reference is not a statutory bar under 35 U.S.C. § 102(b), (c), or (d), an applicant can overcome the rejection by swearing behind the reference through the submission of an affidavit under 37 C.F.R. § 1.131. *In re Foster*, 343 F.2d 980 (CCPA 1965). The cited reference, published PCT patent application WO 00/26103, constitutes a printed publication (MPEP § 901.05). Such a reference may serve as a basis for rejection as of the date of its accessibility to the public, i.e., the publication date (MPEP § 2128). Applicants' accompanying § 1.131 affidavit shows prior possession of the invention which is asserted to be disclosed in WO 00/26103. The date to be overcome under 37 C.F.R. § 1.131 is the date on which the reference is available as prior art (MPEP § 715). Possession of the invention by Applicants occurred prior to the publication date of WO 00/26103, and therefore, the reference cannot be relied upon by the Examiner as prior art rendering Applicants' invention obvious under 35 U.S.C. § 103(a). Applicants respectfully request that the Examiner withdraw this rejection.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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